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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/851,849	05/09/2001	Bruce R. David	10420/12	3674
757	7590	10/18/2004	EXAMINER	
BRINKS HOFER GILSON & LIONE			CADUGAN, ERICA E	
P.O. BOX 10395			ART UNIT	PAPER NUMBER
CHICAGO, IL 60610			3722	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/851,849

Applicant(s)

DAVID ET AL.

Examiner

Erica E Cadugan

Art Unit

3722

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_


Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: see attached

Interview Summary

  
Erica E Cadugan  
Primary Examiner  
Art Unit: 3722

Continuation of 5. does NOT place the application in condition for allowance because: Firstly, regarding applicant's assertions re why the showing of a threaded fastener in Figure 6 as submitted on March 26, 2004 does not constitute new matter are not persuasive. While it is noted that the teaching from the specification that the fasteners are used to secure the guide to the skin "using about 35 in.-lbs. of torque" is noted, and it is agreed that a threaded fastener would require torque as described, Examiner does not agree that a fastener requiring torque would inherently have the form shown in Figure 6 as set forth in the amendment of March 26, 2004. Specifically note that a bolt and nut requires torque as does a fastener that threads directly into the workpiece (as illustrated in the aforementioned Figure 6). Thus, since it is not inherent (in the specification as originally filed) that the fastener extending through the workpiece takes the form of the threaded fastener directly threaded into the workpiece as shown in the aforementioned Figure 6, the aforementioned Figure 6 contains new matter.

Regarding Applicant's assertions with respect to the Glover and Hunt references, it is noted that Applicant's arguments generally assert that neither Glover nor Hunt teach the fasteners drilled "through" the workpiece, and thus neither Glover nor Hunt render the present claims obvious. However, this is not persuasive. Examiner notes that the rejections in question were 103 obviousness rejections that did not rely on explicit teachings in Glover or Hunt for this feature. Instead, Examiner supplied reasoning why it would be obvious to have used whatever length of fasteners on whatever thickness of workpiece was desired, which reasoning Applicant's arguments filed August 12, 2004 do not appear to address. Thus, Applicant's attention is directed to the final rejection mailed June 25, 2004 for a detailed explanation as to why the claims are rendered obvious by Glover and Hunt.